

REMARKS**INTRODUCTION**

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested. No new matter has been submitted.

Claims 1-8, 10-18, 20-27, 29-37, 39-46 and 48-56 are pending and under consideration.

REJECTION UNDER 35 USC 103

Claims 1-8, 10-18, 20-27, 29-37, 39-46 and 48-56 stand rejected under 35 U.S.C. 103 as being obvious over Moody et al. US Patent No. 5,890,177, in view of a portion of a Microsoft publication "Getting Results with Microsoft Office 97" (hereinafter "Office 97"). This rejection is respectfully traversed.

The Office Action appears to set forth the rationale that Moody et al. still discloses the previously relied upon "mail documents," which may be "electronic mail documents," but fails to disclose that the documents are "electronic mail." For this deficiency, the Office Action sets forth that Office 97 "teaches sending a copy of the document a user is working on, to a recipient as an email (page 399)."

The Office Action thereafter states that it would have been obvious to modify Moody et al., in view of Office 97, "because Office teaches getting quick feedback from reviewers (page 396). This would provide the time-saving benefit of directly emailing the documents the user has created using the sophisticated features of the application, such as the wordprocessing application."

Here, applicants believe the disclosure of Office 97 may be slightly misunderstood.

First, the Office Action appears to be setting forth the argument that Office 97 discloses something *different* from attaching a document to an email, as discussed by Moody et al. and acknowledged in the Office Action.

However, the disclosure of Office 97 would appear to merely disclose the same thing as attaching a document to an email.

In Office 97, the document does not become an "email", the document is separate and distinct from the underlying email. See page 399 of Office 97, where the two methods of sending a document are illustrated.

In a first method, in Office 97, an email program can be opened first and the document can merely be attached through the email program.

In the second method, in Office 97, a word processing program may be opened and a process can be initiated where the email program is opened and the document is automatically attached to an email of the same.

This second method is particularly illustrated on page 399 of Office 97, where the document 'Sales Results' is shown to be within/attached to the email with the same subject "sales results."

Thus, the discussion in Office 97 is regarding the attachment of a document to an email and sending that email to different recipients.

The Office Action makes reference to the discussion in Office 97 regarding the potential need for speediness in sharing a document. This is actually discussed on page 397 of Office 97, where three options are shown.

The first option is a bulk sending of the document via different emails from the first sender. The second option is a sequential sending of the document from the first sender, and routing the document through a series of recipients until the document is ultimately sent from a last recipient to the original sender. The third method does not even involve emails, but just discusses that the document could be posted to a shared public folder.

Thus, in at least the first and second options, the documents is attached to an email and forwarded to the different recipients. Further, as illustrated on page 399, the documents in Office 97 are **not** emails, but rather internal parts of emails, e.g., attachments thereof.

The Office Action would appear to still be miss-stating the claimed "documents," in view of the discussion in the present application, as being something other than the actual "email" itself, rather than the contents of the emails.

Attachments and contents of an email are fundamentally different from the email as a whole.

The Office Action has further proffered that it would have been obvious to modify Moody et al. to incorporate the "mail" disclosure of Office 97.

However, as noted above, Office 97 does not disclose the proffered sending of documents as email, but rather sending documents through email, e.g., as attachments, which is the same as that already apparently performed by Moody et al.

Thus, Office 97 fails to disclose the missing electronic documents being the emails themselves, as claimed.

In addition, the Office Action proffered motivation for modifying Moody et al. would not appear appropriate, as the sending of bulk emails, each with a copy of a document, would not appear to be any faster than the method already implemented in Moody et al.

Lastly, it is respectfully submitted that the relied upon motivation still fails to show a connection between controlling the updating of attachments to an email, when there are different users that may modify the attachment, in Moody et al., and why one skilled in the art would dramatically change the invention of Moody et al. to now detect relevance information for an exchange history of the underlying emails.

Moody et al. would appear to be focused on solving a problem related to attachments to emails, e.g., Word documents, a large number of people may modify or change.

Without the teaching from the present application, there would not appear to be any other reason to drastically change the focus of Moody et al. to now focus on relevance information for an exchange history of the underlying emails themselves.

As noted in MPEP 2143.01, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." Citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)(The court reversed the underlying rejection, holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate").

Thus, it is respectfully submitted that it would not have been obvious to modify Moody et al., as proffered in the Office Action.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 be withdrawn and claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 be allowed.

CONCLUSION

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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